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EXAMINER

PAULA, CESAR B

ART UNIT PAPER NUMBER

2178

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,255

Applicant(s)

EISEN, JEFFREY N.

Examiner

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the RCE amendment filed on 8/29/2005.

This action is made Non-Final.

2. In the amendment, claims 24-25 have been added. Claims 1-25 are pending in the case.

Claims 1, 8, 15, 23, and 24 are independent claims.

3. The rejections of claims 1-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (USPub.# 2003/097361, 5/22/2003, filed on 6/15/1999), in view of Barnes, Kate, hereinafter Barnes, "10 Minute Guide to Windows 3.1", Sams, 1992, p. 60-65, have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 8, 15, 23, and 24 recite "the list can be" (lines 14, 14, 17, 15, and 12 respectively). The cited language presents ambiguity into the claims, since the step may or may not be performed.

Drawings

6. The drawings filed on 1/3/2002 have been approved by the Examiner.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (USPub.# 2003/097361, 5/22/2003, filed on 6/15/1999), in view of Barnes, Kate, hereinafter Barnes, "10 Minute Guide to Windows 3.1", Sams, 1992, p. 60-65, and further in view of Outlook 2000 sp-3 copy and paste screendumps, Microsoft Corp., hereinafter Outlook, 1999.

Regarding independent claim 1, Huang discloses displaying to a user a list of received email messages, containing descriptive information—*summary data regarding the email* associated with the information, in a window 320. The user views the email messages by clicking on one of the message information—*summary view of one or more entries to a user, wherein each of the one or more entries is associated with a document; enabling the user to select one or more of the entries listed in the summary view--* (0060, and fig. 3B). Huang fails to explicitly disclose: *receiving input from the user to create a reusable list of the selected entries and to store the list in a system clipboard in response to the input received from the user.*

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However, Outlook teaches the creation of a list by creating a copy of selected email document entries-- *create a reusable list of the selected entries*-- using computer commands (pages1, and 3). Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Moreover, Huang discloses displaying to a user a list of received email messages, containing descriptive information—*for each of the one or more selected document entries, the list includes document summary data pertaining to the document associated with the selected entry*, in a window 320. The user views the email messages by clicking on one of the message information—*hyperlink to the document associated with the selected entry* -- (0060, and fig. 3B). Huang fails to explicitly disclose: *the list can be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view*.

Outlook teaches the creation of a list by creating a copy of selected email document entries, and pasting this copy to a word application document-- *create a reusable list of the selected entries*-- using computer commands (pages1, and 3)-- *the list can be pasted into one or more documents or transferred to one or more programs*. Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents.

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This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Regarding claim 2, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file email entry—*document summary data*-- (0060, and fig. 3B).

Regarding claim 3, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file email entry (0060, and fig. 3B).

Regarding claim 4, which depends on claim 1 Huang the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file email entry— (0060, and fig. 3B). Huang fails to explicitly disclose: *documents that are found by an Internet search engine*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used documents in a discussion thread, because Huang teaches quickly and conveniently accessing links to news, and information over the Internet (0162-0163). This provides the benefit of making it quicker, and easier for a user to retrieve email documents posted on an Internet bulletin board.

Regarding claim 5, which depends on claim 1, Huang the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file

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email entry— (0060, and fig. 3B). Huang fails to explicitly disclose: *documents that are found in a discussion thread*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used documents in a discussion thread, because Huang teaches quickly and conveniently accessing links to news, and information over the Internet (0162-0163). This provides the benefit of making it quicker, and easier for a user of a bulletin board to access, and manipulate email messages included in a thread.

Regarding claim 6, which depends on claim 1, Huang discloses the selection of files displayed on the screen checking a checkbox associated with each of the displayed files (0084-0085, and fig. 7A).

Regarding claim 7, which depends on claim 1, , Huang discloses displaying to a user a list of received email messages, containing descriptive information—*summary data regarding the email associated with the information, in a window 320*. The user views the email messages by clicking on one of the message information (0060, and fig. 3B). Huang fails to explicitly disclose: *inserting, and storing the table in a system clipboard*. However, Outlook teaches the creation of a list by creating copying rows of selected email document entries-- *create a reusable list of the selected entries--* using computer commands (pages1, and 3). Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the

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original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Claims 8-14 are directed towards a computer system for implementing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Claims 15-21 are directed towards a computer readable medium for storing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Claim 22 is directed towards a computer signal embodied in a computing system for implementing the steps found in claim 1, and therefore is similarly rejected.

Claim 23 is directed towards a method equivalent to the steps found in claim 1, and therefore is similarly rejected.

Claim 24 is directed towards a method equivalent to the steps found in claim 1, except for *the summary information including at least one of an author associated with the document or a date associated with the document or a subject associated with the document*, which is taught by Huang's display to a user of a list of received email messages, containing descriptive information, such as a sender of the email -- *an author associated with the document* (0060, and fig. 3B), and therefore is similarly rejected.

Regarding claim 25, which depends on claim 24, Huang's teaches the display to a user of a list of received email messages, containing descriptive information, such as the subject of the email – *a filename of the associated document* (0060; and fig. 3B)

Response to Arguments

9. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection. Regarding claims 1, 8, 15, 23, and 24, the Applicant states that neither Barnes, nor Huang have teaching, suggestion, or motivation to perform the amended claims (pages 9-10). The Applicant is directed towards the rejection of the claims above in light of the newly introduced amendments

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:


Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for **all** Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

11/17/05